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Office-Supreme Court, U.S.
FILED
MAY 18 1959
JAMES R. BROWNING, Clerk

IN THE

Supreme Court of the United States

OCTOBER TERM, 1958.

No. 847

CENTURY INDUSTRIES, INC.,
Petitioner,

vs.

WIEBOLDT STORES, INC.

AND

MARSEL MIRROR & GLASS PRODUCTS, INC.,
Respondents.

BRIEF IN OPPOSITION TO THE PETITION FOR WRIT OF CERTIORARI.

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THE DARTHORP-WARREN PRINTING COMPANY, CHICAGO

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ARGUMENT.

The Petition for a Writ of Certiorari in this case presents no grounds of merit for the grant of such writ.

This Is an Ordinary Patent Action Involving No Unsettled Questions and No Conflicts of Opinion.

This is an ordinary patent infringement action involving a patent which should never have been issued and which is most insignificant in nature. It purports to cover a "kit" whereby an individual, not particularly skilled in the use of tools, can fasten a plurality of mirror squares

to a wall by adhesive rather than nails, holding it in position by a glued tab until the adhesive has dried so as to hold the mirror squares in position. Each and every element entering into the "kit" is old and well known. The glass mirror sections are no different than glass mirror sections which have been known for many years. The adhesive or mastic to be applied to the back of the mirror sections and then to the wall surface is either the ordinary type of mastic or it is a secret mastic not disclosed to the public in the patent in suit. The glued tabs to hold the mirror in position while the mastic dries are old and well known to the public for hanging pictures, mirrors or like articles on a wall. The temporary paper strips between mirror sections to prevent chipping during installation is an old expedient.

The collection of elements entering into the single claim of the patent are all old and well known, perform only the functions which any member of the public would expect them to perform and, as the Court of Appeals for the Seventh Circuit says, in its opinion, the single claim of the patent is merely a "catalogue of the various elements as a whole", which claim is very narrow and "merely recites a combination or aggregation of old elements in which each performed the same function that it had been known to perform".

There is no conflict of opinion between circuits with respect to the patent in suit and, therefore, no confusion between circuits to be settled by a decision of this Court.

The Presumption of Validity Was Considered and Was Held to Have Been Overcome by Clear and Convincing Evidence.

The petition charges that the Court of Appeals for the Seventh Circuit did not "recognize the presumption of validity in petitioner's patent". This is untrue. The Court of Appeals for the Seventh Circuit in its opinion said:

> "We are cognizant of the presumption of validity which attaches to a patent, 35 USCA Sec. 282, but we have concluded that, in this case, such presumption 'was overcome by clear and convincing evidence on the part of the defendants * * *' *Goldman* v. *Robins*, 7 Cir., 245 F. 2d 840, 844 (1957)."

The Court of Appeals' decision in this case is not in conflict with the decision cited by petitioner.

The petitioner implies that there is a conflict of opinion by saying that the Court of Appeals for the Seventh Circuit "should have followed the correct ruling of the C. A. 6 in *Gibson-Stewart Co., Inc.* v. *Wm. Bros Boiler Co.*, 116 USPQ 353" that:

> "a combination patent should not be invalidated by the mere fact that certain elements in the combination were old".

In the first place, the decision is incorrectly cited by the petitioner and it does not appear at 116 USPQ 353. It is to be found, however, in 120 USPQ at page 352 and was decided February 19, 1959. It has not yet appeared in advance sheets of the Federal Reporter, Second Series. Petitioner fails to include in this quotation the remainder of the sentence, however, which is—

> "if invention inheres in the combination * * *" (citing authorities).

Obviously, the Court of Appeals for the Seventh Circuit did not in this case disagree with the actual ruling of the

Court of Appeals for the Sixth Circuit in the cited case since, in the present case, the Court held that there was no invention, saying:

> "In analyzing this single claim it is clear to us that the catalogue of the various elements as a whole do not attain the stature of statutorily patentable matter."

In the *Gibson-Stewart* case, the Court, from its opinion, apparently had before it a combination in which certain elements were old and others new. Yet, in the patent involved in the present case, the Court of Appeals states "We have considered this exhibit" (a collection of prior art) "and find that such teachings" (those of the patent in suit) "are old in the art". Obviously the decision by the Court of Appeals in this case is in no way in conflict with the cited opinion of the Court of Appeals for the Sixth Circuit.

Even If the Patent Were Valid the Single Claim Is Clearly Not Infringed.

The Court of Appeals for the Seventh Circuit, in its Opinion, stated that it saw no good purpose to go into the matter of infringement because of its clear feeling that the patent was invalid. The fact is, however, that the accused structure does not involve or include any of the elements which were finally included by the patentee in the single claim which was granted. The original claims of the patent were rejected and remained rejected. One claim by amendment was allowed and is quoted in the opinion of the Court of Appeals for the Seventh Circuit at page 4A of the Appendix forming a part of the Petition for Certiorari. The mirror set charged to infringe does not involve any of the elements of the claim and is simply a structure comprising angle irons in which mirror glass members are slid

into position, the frame members being *nailed* to the wall surface. Such a frame for exactly such a purpose has long been known in the art and petitioner does not deny it. Where a claim has been allowed by the Patent Office only after rejection and the insertion of numerous elements in the allowed claim, such elements cannot be disregarded under the doctrine of equivalents, which petitioner argues. There is no room for consideration of the doctrine of equivalents where the essential elements of the claim are entirely missing from the accused structure, as is true in this case.

Conclusion.

Since the issues set forth by the petitioner are wholly without merit, it is respectfully requested that the petition be denied.

Respectfully submitted,

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